



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,976	12/06/2004	Fernando Proto Parisi	3182	8676

7590 05/04/2006
Striker Striker & Stenby
103 East Neck Road
Huntington, NY 11743

EXAMINER

POLLIPOFF, STEVEN B

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

Office Action Summary	Application No. 10/516,976	Applicant(s) PROTO PARISI, FERNANDO	
	Examiner Steven B. Pollicoff	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/06/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig 1 reference number 95; Fig 2 reference number 95; Fig 5 reference number 92 and 95.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, in claim 9, the bow structure made of a single ribbon and single tie-strip must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 9 seems to indicate that the means for creating a bow is realized with a single ribbon and single tie strip, a broader embodiment than the pair of ribbons and tie strips presented in claim 4.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1-12, the phrase "and the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

With respect to claim 11, the structure of the joining points of the means for creating a bow does not decrease as shown in Fig 1 and Fig 2. For examination purposes, examiner will interpret the claim to mean that the joining points decrease as the bow is created.

Claim 12 recites the limitation "the area for writing a message" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim that is dependent on

Art Unit: 3728

claim 2. For examination purposes, examiner will interpret claim 12 as being dependent on claim 5. Correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Felton (US Pub 200/0035453).

With respect to claim 1, Felton discloses a set of materials for packaging presents comprises means for containing the presents (Felton Fig 3 generally), for closing the containing means (Fig 2 reference numbers 41 and 42; see also Fig 5 reference number 51A), for creating a decorative "bow" (Fig 3 reference number 64), for writing greetings (Fig 1 reference number 62) and for indicating the names of the sender and recipient (Fig 1 reference number 71).

With respect to claim 2, Felton discloses that the containing means substantially consists of an envelope (Specification page 1 paragraph [0002]).

With respect to claim 3, Felton discloses that the closing means comprise a flap (Fig 1, reference number 23) covering the full width of the front face of the envelope and a self-adhesive strip (Fig 5 reference number 51A) whose width is substantially that of

Art Unit: 3728

the flap, capable of covering the whole width of the border of the rear face of the envelope.

With respect to claim 8, Felton discloses that the envelope is made of paper (Specification page 1 paragraph [0010]).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4,10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Felton (US Pub 200/0035453) as applied to claim 1 above and further in view of White et al., (US Pat 4,777,066).

With respect to claim 4,10 and 11, while Felton discloses a means for creating a bow (i.e. ribbon arranged in such a fashion to create the bow), Felton does not disclose that the means for creating the decorative bow comprises a pair of superimposed

Art Unit: 3728

ribbons in between which is laid a pair of flat tie-strips, also superimposed, the ribbons being joined together by transversally placed pairs of joining points reciprocally distanced on each side of the pair of tie-strips at a distance from said tie-strips such as to allow them to slide freely (and thus decrease the distance between the transversally placed pairs of joining points) between the ribbons, said pairs of ribbons and of tie-strips being joined together at one end, it being thus possible, by causing the free ends of the ribbons to slide in relation to the tie-strips as far as their joined ends, to create in the ribbons a series of folds that spread out side by side from said reciprocally joined ends and form the "bow". However, White discloses a pair of superimposed ribbons (White Fig 4 reference numbers 16 and 17) in between which is laid a pair of flat tie-strips (reference numbers 19 and 20), also superimposed, the ribbons being joined together by transversally placed pairs of joining points reciprocally distanced (reference number 23) on each side of the pair of tie-strips at a distance from said tie-strips such as to allow them to slide freely (and thus decrease the distance between the transversally placed pairs of joining points) between the ribbons, said pairs of ribbons and of tie-strips being joined together at one end (reference number 21), it being thus possible, by causing the free ends of the ribbons to slide in relation to the tie-strips as far as their joined ends, to create in the ribbons a series of folds (reference number 24) that spread out side by side from said reciprocally joined ends and form the "bow". Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the bow of Felton, with a self forming bow having a pair of superimposed ribbons, a pair of flat tie strips and joining points, as taught by White, for

Art Unit: 3728

the purpose of eliminating the need to attach a separately purchased bow to the gift package/envelope (White column 2, lines 29-32).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Felton (US Pub 200/0035453) in view of White et al., (US Pat 4,777,066) as applied to claims 1 and 4 above and further in view of Hagenbuch (US Pat 2,826,225)

With respect to claim 9, Felton as modified above does not disclose that the pair of ribbons and the pair of flat tie-strips are respectively realized with a single ribbon and single tie-strip folded in the middle. However, Hagenbuch discloses a bow realized with a single ribbon and single ties strip (Hagenbuch Fig 6 reference letters, a and e, respectively). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Felton, as modified above, means for creating a bow to include only a means comprising a single ribbon and single tie strip, as taught by Hagenbuch, for the purpose of saving material, reducing manufacturing costs and creating a bow structure unique from a bow created from two of each of the elements.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Felton (US Pub 200/0035453) as applied to claim 1 above and further in view of Michlin et al., (US Pat 5,776,571).

With respect to claim 5, Felton does not disclose that the means for writing a message consists of an area on the rear face of the envelope comprising sides prepared for detachment that permit partial or total removal, at least one non tear-off

Art Unit: 3728

side, there being fixed, by adhesive or other means, to the internal rear face at the position of said area, and a "patch" to ensure continuity of said face even if the area for writing the message is detached or folded back onto one non-tear-off side. However, Michlin discloses means for writing shipping information/a message (Michlin Fig 1 reference number 10) consisting of an area on a face of a package/envelope (Fig 3 reference number 22) comprising sides prepared for detachment that permit partial or total removal (Fig 1 reference number 11 at reference number 13), at least one non tear-off side (Fig 1 reference number 12), there being fixed, by adhesive or other means (Fig 2 reference number 18), to the internal rear face at the position of said area, and a "patch" to ensure continuity of said face even if the area for writing the message is detached or folded back onto one non-tear-off side (Fig 1 reference number 17) to facilitate more efficient shipping of packages (column 1, lines 36-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the means for writing of Felton with the means for writing adhered to the package/envelope, as taught by Michlin, for the purpose having the means for writing better secured to the envelope.

With respect to the placement of the means for writing on the rear face of the envelope, it would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange the means for writing on any surface, front or rear, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Felton (US Pub 200/0035453) as applied to claim 1 above and further in view of Rawlings (US Pat 6,155,481).

With respect to claim 6, Felton does not that the means for indicating the names of sender and recipient is a label applied to an adhesive area on the rear face of the envelope permitting application of the bow on said adhesive area when left free after the label has been transferred to the front face of the envelope. However, Rawlings discloses means for indicating the names of sender and recipient is a label (Rawlings Fig 1 reference number 16) applied to an adhesive area (reference number 24) on a face of the envelope (leaving the adhesive area available for placement of a bow) to facilitate a more efficient return process of a bill payment (Rawlings column 1, lines 11-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the envelope of Felton to include a removable/replaceable label applied to an adhesive area, as taught by Rawlings, facilitate the sending of an envelope to a recipient and allowing a place for a bow to be placed.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Felton (US Pub 200/0035453) as applied to claim 1 above and further in view of Chang (US Pat 5,850,963).

With respect to claim 7, Felton does not disclose that the external face of the containing means presents decorative designs. However, Chang discloses means for

Art Unit: 3728

containing wherein the face presents decorative designs (Chang Fig 1 reference number 56) for enhancing the cheerful atmosphere during the gift giving (Chang column 1, lines 15-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the face of the containing means of Felton to include decorative designs, as taught by Chang, to enhance the gift giving experience.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Felton (US Pub 200/0035453) as applied to claims 1 and 2 above and further in view of Rawlings (US Pat 6,155,481).

With respect to claim 12, Felton does not disclose that the internal face of the area for writing a message presents a self-adhesive layer allowing it to be removed and applied to any other part of the envelope. However, Rawlings discloses an area for writing a message (Fig 1 reference number 18) that has a self adhesive layer (reference number 26) allowing it to be removed and applied elsewhere on the envelope (Fig 1 generally following the arrows and text boxes). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the writing area of Felton to include an area for writing a message with a self adhesive layer, as taught by Rawlings, for the purpose of allowing it to be removed and placed elsewhere on the package for better visibility and securement (Rawlings column 2, lines 59-65).

Conclusion


Art Unit: 3728


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schluger (US Pat 5,490,597) discloses a gift packaging ensemble with an envelope, bow and greeting card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Pollicoff whose telephone number is (571)272-7818. The examiner can normally be reached on M-F: 7:30A.M.-4:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SBP 4/21/06


Mickey Yu
Supervisory Patent Examiner
Art Unit 3728